

Appl. No.: 09/899,645  
Amdt. dated January 12, 2005  
Reply to Office action of October 18, 2004

### **REMARKS/ARGUMENTS**

#### **Status of the Claims**

Claim 5 has been amended as described more fully below in response to a rejection under 35 U.S.C. § 112, first paragraph. In the clause that immediately follows part (d), Applicants have deleted "decreased or" from the claim. As amended, claim 5 recites that "the level of acyl-CoA thioesterase is increased and the level of oil or the level of at least one oil constituent is increased in said plant or at least one part of said plant . . . ."

Claim 6 has been cancelled due to the amendment of claim 5.

Applicants expressly reserve the right to file one or more continuing applications or take such other appropriate measures to protect the subject matter deleted from claim 5 and/or the subject matter of cancelled claim 6.

No new matter has been added by way of amendment of the claims.

Claims 5, 7, 8, 10-14, 17, 21, 22, 24-30, and 37-39 are pending.

Reexamination and reconsideration of the application as amended are respectfully requested in view of the following remarks. The Examiner is respectfully requested to withdraw the rejections to claims 5, 7, 8, 10-14, 17, and 37-39 and to allow these claims. In any event, the Examiner is respectfully requested to enter the above amendments for the purpose of furthering prosecution.

#### **Claims 21, 22, and 24-30 Have Been Allowed**

Applicants respectfully acknowledge that the Examiner has allowed claims 21, 22, and 24-30.

Appl. No.: 09/899,645  
Amdt. dated January 12, 2005  
Reply to Office action of October 18, 2004

The Rejections of the Claims under 35 U.S.C. § 112, First Paragraph, Should Be Withdrawn

Claims 5-8, 10-14, 17, and 37-39 have been rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Claim 6 has been canceled. Claim 5 has been amended. This rejection is respectfully traversed.

The Office Action indicates that the specification is enabling for a method of decreasing  $\beta$ -oxidation in a plant by introduction of an acyl-CoA thioesterase wherein the level of acyl-CoA thioesterase is increased and the level of oil is increased. The Office Action, however, asserts that the specification does not provide reasonable enablement for a method of both decreasing or increasing  $\beta$ -oxidation in a plant by introduction of an acyl-CoA thioesterase wherein the level of an acyl-CoA thioesterase is decreased and the level of oil or an oil constituent is increased in a plant. The Office Action further asserts that the claimed invention is not supported by an enabling disclosure taking into account the *Wands* factors of *In re Wands*, 8 U.S.P.Q. 2d 1400 (Fed. Cir. 1988).

While Applicants do not agree with the rejections of claims 5-8, 10-14, 17, and 37-39 as set forth in the instant Office Action, Applicants have amended claim 5 and cancelled claim 6 in the interest of furthering the prosecution of the instant application and not to limit the scope of Applicants' claimed invention. Applicants expressly reserve the right to file one or more continuing applications or take such other appropriate measures deemed necessary to protect the subject matter deleted from claim 5 and/or the subject matter of cancelled claim 6. Applicants will address, if necessary, the rejections of pending claims 5-8, 10-14, 17, and 37-39 in the continuing application(s).

To place the instant application in condition for allowance, Applicants have amended claim 5 to recite that "wherein the level of acyl-CoA thioesterase is increased and the level of oil or the level of at least one oil constituent is increased in said plant or at least one part of said plant . . . ." As indicated in the Office Action, the specification is enabling for a method of decreasing  $\beta$ -oxidation in a plant by introduction of an acyl-CoA thioesterase wherein the level of acyl-CoA thioesterase is increased and the level of oil is increased. Accordingly, amended claim 5 and its respective dependent claims are enabled.

Appl. No.: 09/899,645  
Amdt. dated January 12, 2005  
Reply to Office action of October 18, 2004

In view of the amendment and remarks, it is submitted that the rejection of claims 5, 7, 8, 10-14, 17, and 37-39 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

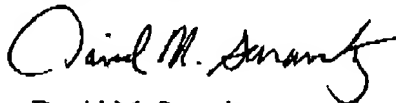
### CONCLUSION

In view of the above amendments and remarks, Applicants submit that the rejections of the claims under 35 U.S.C. § 112, first paragraph, are overcome. Applicants respectfully submit that this application is now in condition for allowance. Early notice to this effect is solicited. In any event, the Examiner is respectfully requested to enter the above amendments for the purpose of furthering prosecution.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is not believed that extensions of time or fees for not addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for not addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



David M. Saravitz  
Registration No. 55,593

Customer No. 29122  
ALSTON & BIRD LLP  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Raleigh Office (919) 862-2200  
Fax Raleigh Office (919) 862-2260